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EXAMINER	
CANTELMO, GREGG	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID SUTHERLAND, VLAD KALIKA and
SCOTT SHERMAN

Appeal 2009-013112
Application 10/708,186
Technology Center 1700

Decided: December 2, 2009

Before BEVERLY A. FRANKLIN, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-9. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

The subject matter on appeal "relates to a planar solid oxide fuel cell stack comprising a floating current collector." (Spec. [0010]). According to Appellants, "a current collector is said to float if it does not directly contact the interconnect to which it is immediately adjacent" (*id.*).

Independent claim 6 is illustrative:

> 6. A planar solid oxide fuel cell stack having a compression plate and a terminal fuel cell, said fuel cell stack comprising:
>
> (a) a current collector plate comprising a substantially planar element disposed immediately adjacent the compression plate;
> (b) an interconnect plate disposed immediately adjacent and in electrical contact with the terminal fuel cell;
> (c) a compressible layer comprising a compressible electrically conductive element in electrical contact with the interconnect plate and the current collector plate.

The Examiner rejected claims 1-9 under 35 U.S.C. § 102(b) as anticipated by Donelson (WO 98/57384, published Dec. 17, 1998).

Appellants argue all of the claims as a group, and do not direct any arguments to any specific claim on appeal (Br. 5-7). Accordingly, we select the broadest independent claim 6 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE AND CONCLUSION

Have Appellants identified reversible error in the Examiner's finding that Donelson teaches the claimed fuel cell stack of independent claim 6 within the meaning of 35 U.S.C. § 102(b)?

On this record, we answer this question in the negative.

FINDINGS OF FACT (FF)

1. We rely upon the Examiner's findings of fact with respect to independent claims 1 and 6 as set forth on pages 3-6 of the Answer, as well as the Examiner's detailed findings of fact in response to the Appeal Brief as set out on pages 6-13 of the Answer in the "Response to Argument" section.
2. Appellants' Specification states "all terms not defined herein have their common art-recognized meaning" (Spec. [0019]). Appellants' Specification contains no explicit definitions of any of the terms used in claim 6 (*see generally* Spec.).
3. Appellants do not provide any credible reasoning or evidence why the common art-recognized meanings of the terms used in claim 6 do not encompass the structure of Donelson as relied upon by the Examiner (Br. 5-7).
4. No Reply Brief has been filed.

PRINCIPLES OF LAW

Burden

The burden is on appellant to identify reversible error in the appealed rejection. *Cf. In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006); *see also* 37 C.F.R. § 41.37(c)(1)(vii).

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631-32 (Fed. Cir. 1987).

However, as stated in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983):

> [t]he law of anticipation does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under attack, as construed by the court, "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it.

Claim Interpretation

It is axiomatic that during examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Although claims are to be interpreted in light of the specification, limitations from the specification are not to be read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 1184-85 (Fed. Cir. 1993).

Enablement of a Prior Art Reference

During "prosecution the examiner is entitled to reject application claims as anticipated by a prior art patent without conducting an inquiry into whether or not that patent is enabled", and the burden is on the applicant to rebut the presumption of operability of the prior art patent by a preponderance of the evidence. *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003); *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990).

ANALYSIS

Appellants contend that "Donelson does not disclose or teach an assembly that addresses the loading between current collection plates and terminal interconnects" (Br. 6). Appellants contend that the teachings of

their specification and Donelson identify "different elements positioned differently in the fuel cell stack" (Br. 7). In summary, Appellants dispute the Examiner's finding of anticipation by merely arguing that Donelson "does not disclose or teach a floating current collector" (*id.*). These arguments are not persuasive of error in the Examiner's findings.

The Examiner explains in detail how Donelson addresses loading between current collector plates and terminal interconnects, and why each claim limitation in dispute is found in Donelson (Ans. 6-13). The Examiner also correctly finds that the claims do not explicitly recite "a floating current collector" and that the claims do not recite structure that defines over the structure of Donelson's fuel stack (Ans. 12, 13).

Appellants have the burden of showing that the Examiner's interpretation of the disputed claim language is unreasonable. See *Kahn*, 441 F.3d at 985-86 (noting that Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position)[1].

However, Appellants do not provide any credible reasoning or evidence why the Examiner's interpretation is unreasonable (Br. 5-7; *see* FF). The Appellants' contentions amount to no more than mere allegations that the reference does not teach the claimed limitations (*id.*).

Appellants' remark that "[t]o anticipate, a piece of prior art must be enabling" (Br. 7) is also unavailing. It is well established that a prior art patent is presumed to be enabling, and that the burden is upon Appellants to

[1] See also *In re Morris,* 127 F.3d 1048, 1056 (Fed. Cir. 1997) ("The appellants urge us to consult the specification … and interpret the disputed language more narrowly in view thereof.... Such an approach puts the burden in the wrong place. It is the applicants' burden to precisely define the invention, not the PTO's." *Id.*

provide facts rebutting this presumption. Appellants have proffered no such evidence on this record.

In summary, Appellants' conclusory remarks do not specifically point out any errors in the Examiner's detailed factual findings as set out in the Answer and thus are not tantamount to the requisite substantive arguments that set forth why the Examiner's findings of fact regarding the claimed features are in error.

Accordingly, Appellants have not shown error in the Examiner's detailed factual findings, claim interpretation, and anticipation analysis of claims 1-9 based on Donelson (Ans. 3-13).

ORDER

The Examiner's rejection of claims 1-9 under 35 U.S.C. § 102(b) as anticipated by Donelson is affirmed.

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal maybe extended under 37 C.F.R. § 1.136(a).

AFFIRMED

tc

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